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APPLICATION NUMBER 05/712,113	FILING DATE 10/17/96	FIRST NAMED APPLICANT MELI	ATTORNEY DOCKET NO. J 50184
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DATE MAILED

EXAMINER

ART UNIT  
1113

PAPER NUMBER  
3

DATE MAILED:

10/14/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

**OFFICE ACTION SUMMARY**

- ☒ Responsive to communication(s) filed on 10/7/96
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire                      month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- ☒ Claim(s) 1-21 is/are pending in the application.
- Of the above, claim(s)                      is/are withdrawn from consideration.
- ☐ Claim(s)                      is/are allowed.
- ☐ Claim(s)                      is/are rejected.
- ☐ Claim(s)                      is/are objected to.
- ☒ Claims 1-21 are subject to restriction or election requirement.

**Application Papers**

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on                      is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on                      is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number)                     .
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received:                     

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15 and 18-20, drawn to photoresist, classified in class 430, subclass 270.1.
- II. Claims 16 and 17, drawn to method of forming an image, classified in class 430, subclass 325.
- III.. Claim 21, drawn to a polymer, classified in class 526, subclass 319.

2. The inventions are distinct, each from the other because of the following reasons:  
Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case product as claimed can be used in a materially different process such as a process for forming parts or structures by injection molding.

3. Inventions III and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph). In the instant case, the intermediate product is deemed to be useful as a resin binder for a layer used to

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protect metal from corrosion and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

4. Inventions III and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polymer as claimed can be used in a material different process such as a process for forming parts or structures by cast molding.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for this Group is (703) 305-3599.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



John S. Chu

Primary Examiner, Group 1100

J.Chu

October 10, 1997